

U.S. Application No. 10/657,406 Examiner Smith, Art Unit 3672
Response to December 20, 2004 Office Action

REMARKS

The United States Patent and Trademark Office (the "Office") objected to the Abstract for implied legal phraseology. Claims 1 and 2 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 2,688,465 to Birdwell in view of U.S. Patent 2,838,285 to Gredell. The Office also rejected claim 3 under 35 U.S.C. § 103 (a) as being unpatentable over *Birdwell* in view of *Gredell* and further in view of U.S. Patent 2,749,102 to Goodrich. The Applicant shows, however, that the amended claims distinguish over any combination of *Birdwell*, *Gredell*, and *Goodrich*. The Applicant thus respectfully submits that the pending claims are ready for allowance.

Discussion with Examiner Smith

Examiner Smith discussed this response. On Tuesday, March 8th Examiner Smith and Scott Zimmerman held a telephone interview. The retractable, swinging cutters of *Birdwell* were discussed and compared to claim 1. As *Birdwell* explains, his cutters must swing radially outwardly of the ring "whereby the pipe may be advanced with the advance of the auger" (*Birdwell* at column 1, lines 9-11). Examiner Smith then suggested the term "fixed" to distinguish the Applicant's auger from the various combinations of *Birdwell*, *Gredell*, and *Goodrich*. The Applicant adopts this suggestion and amends claim 1.

Examiner Smith, please feel free to contact Scott Zimmerman. Should you feel an examiner's amendment would advance this case to allowance, please feel free to call for authority.

Objection to the Abstract

The United States Patent and Trademark Office (the "Office") objected to the Abstract for implied legal phraseology. The originally-submitted Abstract of the Disclosure (paragraph

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[0043]) has been replaced to remove the implied terminology. No new matter is added, and Examiner Smith is thanked for this suggestion.

Rejection of Claims 1 & 2 under 35 U.S.C. § 103 (a)

Claims 1 and 2 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 2,688,465 to Birdwell in view of U.S. Patent 2,838,285 to Gredell. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Applicant shows, the proposed combination of *Birdwell* and *Gredell* fails to teach or suggest all the features recited in claim 1.

Amended claim 1 is not obvious. Claim 1 includes features not taught or suggested by the proposed combination of *Birdwell* and *Gredell*. Claim 1, for example, recites "an outer blade, the outer blade comprising an outer ring and an inner hub, the outer ring having an array of circumferentially-spaced teeth along the outer ring, with each tooth fixed to the outer ring." Support for this amendment may be found at least in FIGS. 11-14. Amended claim 1 is reproduced below.

1. (Currently Amended) An auger bit for an auger, the auger for boring a hole, the auger bit comprising:

an outer blade, the outer blade comprising an outer ring and an inner hub, the outer ring having an array of circumferentially-spaced teeth along the outer ring, with each tooth fixed to the outer ring, the inner hub substantially concentric to the outer ring, the inner hub inwardly spaced from the outer ring by an array of inner spokes, each spoke in the array of inner spokes having a bladed portion for removing material;

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a center bit inserted into the inner hub, the center bit comprising a drill bit-shaped tip, a toothed cone, and a shaft, the drill bit-shaped tip, the toothed cone, and the shaft all concentrically aligned with the outer ring and with the inner hub, the toothed cone having at least one blade outwardly protruding from a conical portion, the blade having an edge, and the shaft inserting into the inner hub to center the center bit with the outer ring and with the inner hub,

wherein the drill bit-shaped tip centers the auger bit, the array of circumferentially-spaced teeth for moving soil and cutting roots, and the at least one blade outwardly protruding from the toothed cone also for moving soil and cutting roots.

The proposed combination of *Birdwell* and *Gredell* fails to obviate claims 1 & 2. *Birdwell* describes "retractable cutters" that "swing radially outwardly of the ring" (U.S. Patent 2,688,465 to Birdwell at column 1, lines 12-15). Several times, in fact, *Birdwell* describes these cutters as being "retractable" (column 1, line 40), "pivotally support[ed]...for radial swinging movement (column 2, lines 18-19), and "swinging outwardly" (column 2, line 40). As *Birdwell* explains, his cutters must outwardly swing from the ring "whereby the pipe may be advanced with the advance of the auger" (*Birdwell* at column 1, lines 9-11). No where does *Birdwell* contemplate that these cutters could have a fixed configuration. A fixed configuration, in fact, would destroy the purpose and principle of *Birdwell*'s design. Because *Birdwell* is completely silent to "the outer ring having an array of circumferentially-spaced teeth along the outer ring, with each tooth fixed to the outer ring." the proposed combination of *Birdwell* and *Gredell* fails to obviate claims 1 & 2. The Applicant thus respectfully requests that Examiner Smith remove the § 103 (a) rejection and allow claims 1 and 2.

Rejection of Claim 3 under 35 U.S.C. § 103 (a)

The Office also rejected claim 3 under 35 U.S.C. § 103 (a) as being unpatentable over *Birdwell* in view of *Gredell* and further in view of U.S. Patent 2,749,102 to Goodrich. Claim 3, however, depends from claim 1 and thus incorporates the same distinguishing features. Claim 3, for example, includes "an outer blade, the outer blade comprising an outer ring and an inner hub, the outer ring having an array of circumferentially-spaced teeth along the outer ring, with each

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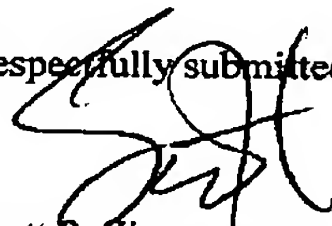
tooth fixed to the outer ring." The proposed combination of *Birdwell*, *Gredell*, and *Goodrich* is completely silent to such features. The proposed combination of *Birdwell*, *Gredell*, and *Goodrich*, then, cannot obviate claims 1 and 3. The Applicant thus respectfully requests that Examiner Smith remove the § 103 (a) rejection and allow claims 1 and 3

Prima Facie Cases Must Fail for Lack of Expectation of Success

The Examiner's attempted *prima facie* case for obviousness fails to establish any expectation of success. If the Office wishes to establish a *prima facie* case of obviousness, the Examiner must identify a reasonable expectation of success. See DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). Here the Examiner attempts to combine diverse features of multiple patents to produce a *prima facie* case. The Examiner, however, has failed to establish how one of ordinary skill in the art would expect success when making this combination. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,



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